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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/765,332 | 01/26/2004 | Takashi Ikeda | 393032043200 | 9951 |
| 25224 | 7590 | 07/26/2005 | EXAMINER | |
| MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024 | | | AUGUSTIN, EVENS J | |
| | | ART UNIT | PAPER NUMBER | 3621 |

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/765,332 | IKEDA ET AL. | |
| | Examiner | Art Unit | |
| | Evens Augustin | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 January 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/26/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-15 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims as presently claimed and best understood were considered in light of the new “Examination Guidelines for Computer-Related Inventions” and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

As per claim 5, the preamble recites “A song data reproduction program for use in a song data reproduction apparatus...” however, does not recite that the computer program is encoded or recorded on a physical medium readable by a computer. Thus, the claim is directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media (defined as “a collective word for the physical material, such as paper, disk, and tape, used for storing computer-based information”, Microsoft Press, Computer Dictionary, Second Edition, © 1994) are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. Such claimed data structures do no define any structural and functional interrelationships between the data structure. See MPEP 2106(IV)(B)(1)(a).

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 9, the preamble recites “a computer readable medium for recording song data...”, however, lacks any recitation of any specific computer or computer implemented device and results in a claim that recites functionally descriptive material (defined as “data structures and computer programs with impart functionality when encoded on a computer readable medium” by the Computer-Implemented Invention Guidelines) without any interrelationships between the data structure and other aspects of the invention that would permit the data structure’s functionality to be realized.

Claim Rejections - 35 USC § 112

1. Claims 3, 7, 11 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 3, 7, 11 and 15, the applicant recites the term “specifying a channel among a plurality of channels”. The specification fails to clearly define to one of ordinary skills in the art the proper meaning of the term. The applicant must particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiser et al. (U.S 6385596).

As per claims 1-45, Wiser et al. disclose a computer system that relates to development architecture frameworks, and more particularly to managing an environment of a development framework. The computer system comprises of the following:

- Client/server architecture with a clients computer system connected with a server online music distribution system that provides consumers with flexibility and ease of use in the selection, previewing, downloading, and transporting of audio and other digital media over the Internet, and that provides for security of the media throughout the distribution system (column 3, lines 5-20) – *Claims 1, 5*
- The media player is the mechanism by which the consumer plays back purchased or previewed audio data, and by which the consumer digitally records purchased media data files to a further external memory, such as a CD-Recordable, CD-RW, Mini-Disc, flash memory, or the like. The media player provides user interface controls for viewing lists of purchased and stored media data file, viewing cover and promotional art and graphics, reading lyrics and other liner information, organizing play lists and tracklists, and other music database management features (column 10, lines 1-16) - *Claim 5*
- System limiting the reproduction/copies of content (column 3, lines 33-50, column 4, lines 42-50, column 7, lines 27-37) – *Claims 1, 5, 9*

- The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55) –
Claims 1, 2, 6, 10
- Generation usage rights associated with the content (column 10, lines 45-47, column 11, lines 1-6) – *Claims 1, 5, 9*
- Allowing users to store content in their hard disks (column 11, lines 42-45) - *Claims 1, 5*
- The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth requirement. The media player also provides port information identifying which ports it is to receive the streamed audio data from the delivery serve (column 15, lines 33-43) - *Claims 3, 7, 11*
- The audio content contains a mechanism that allow is to provide different functions such as quality levels on playback, using different sampling rates and compression levels. The mechanism also includes optional functions such as restrictions on playback and record to external devices or files (column 7, lines 4-16) – *Claims 4, 8, 12*
- An online music distribution system in accordance with the present invention includes a variety of cooperative components that communicate over a public network, preferably the Internet. These components include a content manager, one or more delivery servers, a media data file system and media information database. HTTP servers facilitate Internet communications by the system. Any number of individual purchasers use client computer systems with Web browsers and media players (column 3, lines 9-19) – *Claim 13*

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- Server is responsible for receiving requests from a media player to preview or purchase a media data file containing audio data (column 9, lines 56-58) - *Claim 13*
- Server transmitting the requested media file to the user (column 9, lines 60-67) - *Claim 13*
- The media files transmitted the user contains descriptive text, such as title, artist, lyrics, and liner notes, promotional art image data, and cover art image data (column 6, lines 59-62), and also contains mechanism to ensure usage rights are executed (column 7, lines 4-16) – *Claim 13*
- Once the audio is has been purchased, the server gives the user the appropriate licensing and updated its records accordingly (column 19, lines 11-49) - *Claim 14*
- The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55), The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth requirement. The media player also provides port information identifying which ports it is to receive the streamed audio data from the delivery serve (column 15, lines 33-43). The audio content contains a mechanism that allow is to provide different functions such as quality levels on playback, using different sampling rates and compression levels. The mechanism also includes optional functions such as restrictions on playback and record to external devices or files (column 7, lines 4-16) – *Claim 15*

Conclusion

5. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - **Dows et al. (US 6226618)** - The invention disclosed broadly relates to the field of electronic commerce and more particularly to a system and related tools for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
July 14, 2005
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Beth A. Augustin
PRIMARY PATENT EXAMINER